

1 REMARKS

2 Status of the Claims

3 Claims 1-8 and 10-33 remain pending in the application. Claims 1, 10, 18, and 24 have been
4 amended to more clearly define the invention, and Claim 9 has been cancelled.

5 Claims Rejected Under 35 U.S.C. § 112

6 Claims 18-23 remain rejected under 35 U.S.C. § 112, first paragraph, as failing to comply
7 with the written description requirement. The Examiner asserts that the claims contain subject matter
8 that was not described in the specification in such a way as to reasonably convey to one skilled in the
9 relevant art that the inventors, at the time the application was filed, had possession of the claimed
10 invention. Claim 18 has been amended to delete the phrase "unless said data are already in the
11 compressed format." Accordingly, this rejection of Claims 18-23 has been fully addressed and
12 should be withdrawn.

13 Claims Rejected Under 35 U.S.C. § 102(b) over Corel WordPerfect 6.1

14 The Examiner has rejected Claims 1-2, 5, 6, 9-10, 12-13, 15-17, 24-25, and 27-31 as being
15 anticipated by Corel WordPerfect 6.1, 1996 ("Scan Images into WordPerfect", "Scanner Setup",
16 "Image Settings", and "Image Tools", hereinafter referred to as the "WordPerfect reference"). The
17 Examiner asserts that WordPerfect describes each element of applicants' claimed invention.
18 Applicants respectfully disagree for the reasons discussed below. Nevertheless, applicants have
19 amended independent Claims 1 and 24 to more clearly define the invention, as further discussed
20 below. In the interest of reducing the complexity of the issues for the Examiner to consider in this
21 response, the following discussion focuses on amended independent Claims 1 and 24. The
22 patentability of each remaining dependent claim is not necessarily separately addressed in detail.
23 However, applicants' decision not to discuss the differences between the cited art and each dependent
24 claim should not be considered as an admission that applicants concur with the Examiner's
25 conclusion that these dependent claims are not patentable over the disclosure in the cited references.
26 Similarly, applicants' decision not to discuss differences between the prior art and every claim
27 element, or every comment made by the Examiner, should not be considered as an admission that
28 applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed,
29 applicants believe that all of the dependent claims patentably distinguish over the references cited.
30 Moreover, a specific traverse of the rejection of each dependent claim is not required, since

1 dependent claims are patentable for at least the same reasons as the independent claims from which
2 the dependent claims ultimately depend.

3 With respect to amended independent Claim 1, the Examiner asserts that the WordPerfect
4 reference anticipates applicants' Claim 1 because the WordPerfect reference teaches the acquisition
5 and insertion of a scanned image from a TWAIN scanner under control of a word processing
6 application into a text document. The Examiner further asserts that the insertion of the scanned
7 images into the textual documents is done directly from the scanner, that is, without saving the image
8 into a permanent file in the computer memory prior to inserting the file into the textual document.
9 The Examiner cites Page 1 and 5 of the WordPerfect reference.

10 Applicants assert that the Examiner has not shown that this reference actually anticipates the
11 explicit function of communicating data representing an image from the image source device into the
12 memory of the computer so that the data representing the image comprises a portion of the document
13 stored in the memory of the computer, *all without saving the data to any permanent file prior to*
14 *communicating the data into the document stored within the memory of the computer.* Support is
15 provided for this portion of Claim 1 by the specification that explains:

16 The image is acquired or provided by an active image acquisition device, which
17 can be a default device or one selected from a list of available devices generated by the
18 system, and inserted into the application program document so that when the document is
19 saved to a file, the captured image comprises a portion of the file. Furthermore, although
20 it may be temporarily saved into a buffer, the **captured image is never saved to a**
21 **permanent file** – that is a file that persists after the application program is closed or the
computer is shut down during the process that inserts the image into document produced
by the application program. (Emphasis added, specification, page 3, lines 18-26.)

22 Page 1 of the WordPerfect reference may recite “scan an image ... *directly* into WordPerfect,”
23 but it is not clear that the image is not first converted into a file and then imported directly into the
24 WordPerfect document. The word “directly” can be interpreted in many ways. For example, the
25 word “directly” might mean that from *within* WordPerfect, a user can **directly** open a scanning utility
26 and create a file that is then imported into the WordPerfect document. In any case, WordPerfect does
27 not teach or suggest any details about how an image is actually acquired and inserted into the
28 document. Where one of ordinary skill might reach many different conclusions as to what is meant
29 by the word “directly” in the recitation of the WordPerfect reference, the reference fails to provide a
30 disclosure that supports the Examiner's assertion that this step of Claim 1 is taught or even obvious in

1 view of the WordPerfect reference. Clearly, this cited reference does not expressly state that the
2 document is stored within the computer memory **without saving the data to a permanent file.**

3 Nevertheless, applicants have amended Claim 1 to more clearly distinguish their method for
4 inserting an image into a document stored in a memory of a computer to include the recitation of
5 dependent Claim 9, which is now canceled. Please see the discussion below for an explanation of
6 why this step patentably distinguishes over all of the cited art. Accordingly, the rejection of
7 independent Claim 1 under 35 U.S.C. § 102(b) over WordPerfect should be withdrawn for the
8 reasons given above.

9 With regard to independent Claim 24, the Examiner asserts that Claim 24 is directed towards
10 “a system for implementing the steps found in Claims 1, and 1 (*sic*) respectively, and therefore are
11 similarly rejected” (Office Action, page 6, lines 7-8). Applicants continue to assert that the Examiner
12 has failed to cite any reference that anticipates the explicit function of step (f), where an interface
13 module comprising computer-executable instructions stored in the memory and in communication
14 with the source manager module and under control of the application program provides commands to
15 the source manager to acquire an image using the image acquisition device, the interface module
16 inserting the image data representing the image into the document that is stored in the memory of a
17 computer *without saving said image data to any permanent file prior to inserting the image data into*
18 *the document stored in the memory of the computer.* Again, page 1 of the WordPerfect reference may
19 recite “scan an image *directly* into WordPerfect,” but it is still not clear that the image is not first
20 scanned and stored as a file and that file then imported. Thus, the WordPerfect reference does not
21 teach or suggest this feature of Claim 24, because the reference does not expressly state that the
22 document is stored within the computer memory without saving the data to a permanent file. The
23 Examiner seems to place undue reliance on a single interpretation of the word “directly.”

24 Although the Examiner asserts that Claim 24 is rejected for similar reasons as used for the
25 Examiner’s rejection of Claims 1 “and 1” (applicants presume this is a typographical error and that
26 the Examiner meant to reference Claim 1 only), note that there is no mention in Claim 1 of a source
27 driver module, a source manager module and an interface module as applicants claim in steps (d), (e),
28 and (f), respectively, of Claim 24. Thus, it is not clear what reasons the Examiner is using to reject
29 Claim 24, since Claim 24 contains additional elements not present in Claim 1. Furthermore,
30 applicants cannot find any suggestion of these elements in the 5 pages of the WordPerfect reference

1 printout. Nevertheless, applicants have also amended Claim 24 to include the recitation of Claim 9 to
2 more clearly define their system for inserting an image into a document. Please see the discussion
3 below regarding Claims 2, 6, 9-10, 12, and 17 Rejected Under 35 U.S.C. § 103(a)” for a discussion of
4 why the added recitation from Claim 9 is patentably distinguishable over the cited art. Accordingly,
5 the rejection of independent Claim 24 under 35 U.S.C. § 102(b) over WordPerfect should be
6 withdrawn for the reasons given above.

7 Claims 2, 6, 9-10, 12, and 17 Rejected Under 35 U.S.C. § 103(a)

8 Claims 2, 6, 9-10, 12, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over
9 WordPerfect and in view of “Ulead PhotoImpact 3.0 User Guide for Windows 95 and
10 Windows NT 3.51” 1996, (hereinafter “PhotoImpact”). In regard to canceled Claim 9 (the substance
11 of which is now recited in independent Claims 1 and 24, the Examiner asserts that Photoimpact
12 discloses the setting of *postprocessing* options for adjusting, and enhancing images to be scanned into
13 the computer. Indeed, the post-processing options in the Acquire Image dialog box enable the user to
14 apply several basic enhancements to an acquired image (PhotoImpact, page 165, lines 4-6). In
15 contrast, applicants’ claimed method includes the step of causing the application program to negotiate
16 with the image source device that is active to determine a set of image capture parameters that control
17 the image source device *when acquiring* the image. Applicants’ claimed method does not operate
18 *after* an image has been acquired, but instead, *during* the time the image is being acquired. Thus,
19 Photoimpact neither teaches nor suggests applicants’ recited step of causing the application program
20 to negotiate with the image source device that is active to determine a set of image capture
21 parameters that control said image source device *when acquiring the image*. Accordingly, the
22 rejection of dependent Claim 9 under 35 U.S.C. § 103(a) was improper and Claims 1 and 24, which
23 now include the recitation of canceled Claim 9 are clearly patentable over the cited art for the reasons
24 given above.

25 Since Claims 2, 6, 10, 12, and 17 depend from independent Claim 1, which is patentable for
26 the reasons discussed above, accordingly, the rejection of dependent Claims 2, 6, 10, 12, and 17
27 under 35 U.S.C. § 103(a) should also be withdrawn, since these claims are patentable for the same
28 reasons as Claim 1.

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1 Claims 4-5, 18, 21-23 and 32-33 Rejected Under 35 U.S.C. § 103(a)

2 Claims 4-5, 18, 21-23, and 32-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable
3 over the WordPerfect reference, in view of Sobol et al. (U.S. Patent No. 5,907,665 hereinafter
4 "Sobol"). However, Claims 4-5 and 32-33 depend from independent Claims 1 and 24 which are
5 patentable for the reasons discussed above. Accordingly, the rejection of dependent Claims 4-5
6 and 32-33 under 35 U.S.C. § 103(a) should be withdrawn.

7 In addition, Claims 21-23 depend from independent Claim 18, which is patentable for the
8 reasons discussed below and thus, the rejection of dependent Claims 21-23 under 35 U.S.C. § 103(a)
9 should be withdrawn. Regarding independent Claim 18, the Examiner asserts that WordPerfect
10 teaches (on page 1-2, and 5) the acquisition, transfer, and insertion of scanned images, from an active
11 TWAIN scanner, under control of a word processing application, into a textual document located in
12 the word processing application. The scanning and insertion of the images is typically made using a
13 scheme or a number of prescribed steps. However, having reviewed the cited art, applicants can find
14 no reference *to providing a selection scheme* within the application program for selecting a *plurality*
15 *of images (as applicants recite in step (a) of Claim 18) or enabling a user to use the selection scheme*
16 *(as applicants recite in step (b) of Claim 18)*. Furthermore, Step2 on page 1 of the WordPerfect
17 reference states that a user should consult scanner software documentation for how to manipulate the
18 image and paste it to WordPerfect. Thus, the disclosure by reference to manipulating and pasting a
19 *single* image implies that there is no selection scheme for selecting a plurality of the images for
20 insertion into the image. In contrast, applicants' Claim 18 clearly recites that "the image source
21 device user interface provides a selection scheme within the application program for selecting a
22 plurality of the images stored in the image source device for insertion into the document," and the
23 user selects the plurality of images to be inserted (see applicants' specification, page 4, lines 31-33).

24 Furthermore, as described above in connection with Claim 1 and Claim 24, the WordPerfect
25 reference does not expressly state that the document is stored within the computer memory without
26 saving the data to a permanent file. Therefore, the WordPerfect reference, in view of Sobol, does not
27 teach or suggest all of the steps of Claim 18, and accordingly, the rejection of Claim 18 should be
28 withdrawn.

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1 Other Claims Rejected Under 35 U.S.C. § 103(a)

2 Claims 7-8, 19, and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the
3 WordPerfect reference, and in view of "Mastering Photoshop 5 for the Web," 1998 (hereinafter
4 "Photoshop"). However, Claims 7-8, 19, and 31 variously depend from independent Claims 1, 18,
5 and 24, which are patentable for the reasons discussed above. Accordingly, the rejection of
6 dependent Claims 7-8, 19, and 31 under 35 U.S.C. § 103(a) should be withdrawn, since these claims
7 are patentable for at least the reasons as the independent claims from which they ultimately depend.

8 Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the WordPerfect
9 reference, in view of "Troubleshooting and configuring the Windows NT/95 Registry," 1997
10 (hereinafter "Johnson"). However, Claim 11 depends from independent Claim 1 and is patentable for
11 at least the same reasons discussed above. Accordingly, the rejection of dependent Claim 11 under
12 35 U.S.C. § 103(a) should be withdrawn.

13 Claim 14 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over WordPerfect
14 and in view of Arakawa (U.S. Patent No. 5,845,076 hereinafter "Arakawa"). However, Claim 14
15 depends from independent Claim 1 and is patentable for at least the same reasons discussed above.
16 Accordingly, the rejection of dependent Claim 14 under 35 U.S.C. § 103(a) should be withdrawn.

17 Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over WordPerfect, in
18 view of Sobol and further in view of Hearn et al. (U.S. Patent No. 6,154,756 hereinafter "Hearn").
19 However, Claim 20 depends from independent Claim 18 and is patentable for at least the same
20 reasons discussed above. Accordingly, the rejection of dependent Claim 20 under 35 U.S.C. § 103(a)
21 should be withdrawn.

22 Claim 26 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the WordPerfect
23 reference, in view of Hearn. However, Claim 26 depends from independent Claim 24 and is
24 patentable for at least the same reasons discussed above. Accordingly, the rejection of dependent
25 Claim 26 under 35 U.S.C. § 103(a) should be withdrawn.

26 Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the WordPerfect
27 reference, in view of TWAIN specification version 1.8, 1998 (hereinafter "TWAIN"). However,
28 Claim 13 depends from independent Claim 1 and is patentable for at least the same reasons discussed
29 above. Accordingly, the rejection of dependent Claim 13 under 35 U.S.C. § 103(a) should be
30 withdrawn.

1 In view of the amendments and Remarks set forth above, it will be apparent that the claims in
2 this application define a novel and non-obvious invention, and that the application is in condition for
3 allowance and should be passed to issue without further delay. Should any further questions remain,
4 the Examiner is invited to telephone applicants' attorney at the number listed below.

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6 Respectfully submitted,

7 *Ron Anderson*
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11 RMA/SKM:lrg

12 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed
13 envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents,
14 Alexandria, VA 22313-1450, on June 24, 2004.

15 Date: June 24, 2004

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